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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,034	01/08/2002	Donald X. Smith II	10019438 -1	6127

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EXAMINER

LE, THIEN MINH

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,034

Applicant(s)

SMITH, DONALD X.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 7-26 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other:

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DETAILED ACTION

The information disclosure statement filed on 1/8/2002 has been entered.

Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al. (herein referred to as Kaufman – 5,991,411).

Kaufman discloses the method and means for encrypting on a credit card (i.e. optical or magnetic stripe cards; see Fig. 1) a small refreshable encoded record which specifies where the card was last used when it was last scanned for approval of a commercial transaction. The record of this latest transaction is recorded on the card whether or not the transaction was actually approved. When the card is scanned at the point of sale, all of the credit card information is read, along with the coded record of the last transaction. Concurrently, the record is overwritten or appended with a new encrypted code for the present transaction. Such information can be augmented with voice-recorded information obtained from the card bearer. All this information is sent to the credit card approval computer which performs all of the usual checks. Additionally, the last transaction code is checked against a database at the host in order to ascertain whether this card is in fact the same card that made the latest recorded skeletal transaction (as opposed to a telephone pick order or transaction). If not, the card is invalid. Again, this results whether or not the recorded transaction was approved. If valid, the new transaction record is added to the card company database and labeled as the latest transaction. Since Kaufman disclose the method and means for recording voice message, the use of a microphone, an input/output connector, a controller are considered inherent in his teachings.

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The claim differs in calling for a smart card comprising a memory rather than optical or a magnetic recording media. It would have been obvious to apply Kaufman's teachings to smart cards. The modification is merely a substitution of one type of recording media with another type of recording media; and thus would have been well within the skill levels and expectations of an ordinary skilled artisan. Further, it is noted that while Kaufman discloses the use of his teachings for optical and/or magnetic stripe cards, he also suggests that such method and means can rely upon equivalent technology for encoding and recording information on cards and badges, reading information from cards and badges, and processing the information so sensed or read.

Regarding claim 2, Kaufman mentions the method of recording voice message from the card's owner. Since typical voice/audio capturing system would include a microphone, an A/D converter, a memory, a controller, etc., the suggestion set forth in Kaufman would embrace the limitations set forth in this claim.

Regarding claim 3, see the discussions regarding claim 2.

Regarding claim 7, Kaufman discloses the typical credit and debit cards where user's authorization step would be considered inherent.

Claims 8-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al. (herein referred to as Kaufman – 5,991,411) in view of Barratelli (6,325,285).

Regarding claim 8-26, see the discussions above regarding claims 1-3 and 7.

The claims differ in calling for a printer for printing transaction record, a voice

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authorization unit, a display, etc. It would have been obvious to incorporate these limitations in the system as taught by Kaufman. Official Notice is taken of the use of a printer for printing receipt of financial transactions. The use of the printers are known in commercially available in retail store systems, banking systems, ATMs, etc. Without any unexpected result, modifying Kaufman's teaching to include a printer would have been well within the skill levels and expectations of an ordinary skilled artisan. As to the claimed method and means for voice recognition and verification, reference to Barratelli is cited as evidence showing the use of a voice verification system for smart cards. Specifically, Barratelli discloses a smart card of the comprising a microphone, a voice recognition hardware/software 212 for converting voice sounds received via microphone 116 into an electrical representation of a user's voice. It would have been obvious to incorporate Barratelli's teachings in the system as taught by Kaufman. The modification offers an alternative method for verifying and authorizing financial transactions. As to the claimed method for recording balance, transaction value, transaction date, etc., Kaufman's teachings of recording transaction history/record and the typical operation of credit/debit cards would embrace all limitations set forth in these claims.

Allowable Subject Matter

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose a smart card comprising a microphone, a memory, a controller, an input/output connector, and especially, the plurality of switches that control the operation of the microphone in the manner as recited in claim 4, and the touchscreen as recited in claim 6.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Le, Thien Minh
Primary Examiner
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June 16, 2003